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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,440	06/24/2003	Janice E. Buck	890-01-PA	9414
22145	7590	04/30/2004	EXAMINER	
KLEIN, O'NEILL & SINGH 2 PARK PLAZA SUITE 510 IRVINE, CA 92614			LE, HUYEN D	
			ART UNIT	PAPER NUMBER
			3751	

DATE MAILED: 04/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,440

Applicant(s)

BUCK, JANICE E.

Examiner

Huyen Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 06/24/03
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 9-12, 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckner.

The Buckner reference discloses a writing instrument comprising a barrel 26 having first end, the barrel having a first maximum diameter; a writing tip extending from the first end; and a page turning element 10 fixed to the second end of a writing instrument or a variety of writing instruments (col. 3, lines 60-61).

Although the Buckner reference does not specifically disclose that the maximum diameter of the turning-page device is not substantially greater or 25% or 50% greater than the maximum diameter of the barrel of the writing instrument, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select diameter within a certain range for a page-turning device that best fits a particular writing instrument and to optimize the performance. See *In re Aller*, 105 USPQ 233, using the optimum or workable ranges involves only routine skill in the art.

Regarding claim 4, the page turning element 10 is made of a soft, deformable, substantially non-abradable, substantially non-abrasive elastomeric material (col. 3, lines 54-56).

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Regarding claims 5 and 6, the page turning element has a textured exterior surface which includes a multiple of soft, deformable protuberances 16.

Regarding claims 11 and 12, the page turning element has a textured exterior surface which includes a multiple of soft, deformable protuberances 16.

3. Claims 7, 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckner (5,735,544) in view of Kamo (3,813,176).

Although the Buckner reference does not specifically disclose writing instrument which includes an actuation button on the exterior of the main portion of the barrel, attention is directed to the Kamo reference which discloses a writing instrument including a side actuation button.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to attach the Buckner page-turning device to a writing instrument that has a side actuation button in view of the teaching of the Kamo reference, wherein so doing would amount a mere substitution of one functional equivalent writing instrument for another within the same art that would work equally well with the Buckner page-turning device.

4. Claims 8, 14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckner (5,735,544) in view of Sears (3,133,526).

Although the Buckner reference does not specifically disclose writing instrument which includes an actuation button one end of the barrel, attention is directed to the Sears reference which discloses a writing instrument including an actuation button extending from one end of the barrel.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to attach the Buckner page-turning device to a writing instrument that has an actuation button at one end in view of the teaching of the Sears reference, wherein so doing would amount a mere substitution of one functional equivalent writing instrument for another within the same art that would work equally well with the Buckner page-turning device.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Deli, Oelke and DE 29502759 references disclose a writing instrument having an attachment at one end which is capable of being used as a page-turning device.

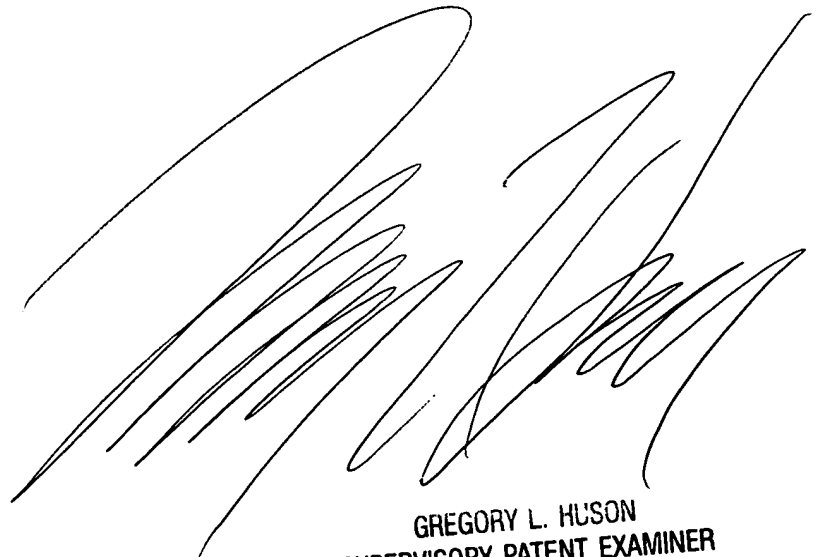
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huyen Le whose telephone number is 703-306-5504. The examiner can normally be reached on Monday-Friday from 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on 703-308-2580. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HL
April 29, 2004



GREGORY L. HUSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700